APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,736	05/31/2000	Avner Shafrir	52817.000112	2786

29315   7590   05/28/2004

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILLS ROAD
SUITE 900
RESTON, VA 20190

EXAMINER
HAILU, TADESSE

ART UNIT	PAPER NUMBER
2173	21

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td></td><td></td></tr>
</table>

	Application No.	**Applicant(s)**	
Office Action Summary	09/583,736	SHAFRIR ET AL.	
	Examiner	**Art Unit**	
	Tadesse Hailu	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 March 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the AMENDMENT entered on March 22,

2004 for the patent application number 09/583,736.

2.   The present patent application claims priority from domestic US Application

60/137,513 filed April 2, 1999.

3.   The pending claims 1-33 are examined as follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mirabilis LTD. Quick Tour. February 12 1998 in view of ICO Inc, 1CQ Email Signature,

May 2 1999.

ICQ, as disclosed in Mirabilis LTD, Quick Tour, is an application that is used as

a tool for communication. After installing this software application in a computer, ICQ

allows you to know who is online (network), and allows you to contact them by clicking

the name or the icon next to it and then send a message, initiate a chat session or

launch any other interactive session (communication mode). ICQ automatically detects

user connection to the Internet and announces your presence (on-line status indicator)

to those whose list (contact list) you are on and notifies you if your contacts are on-line

(status indicator) as well. Thus status indicator is color-coded symbol (flower icon), i.e., it changes to green to announce your presence to those whose list you are on.

Furthermore, as described below, it is clear that the current claims are not distinguishable over the cited art.

With regard to claim 1:

Claim 1 recites, among other things, "communication selection means," ICQ, as described in Quick Tour, describes that users can launch any one of the communication modes selected from a user's menu, such as chat (in real time), e-mail, etc. The status indicator reflects the selected mode of communication (Quick Tour, pages 6-7).

As per "communication means," ICQ, as described in Quick Tour, allows you to contact other 1CQ users on the Internet by clicking the name (identifier) or the icon next to it and then send a message, initiate a chat session (real-time) or launch any other interactive session (communication mode) (Quick Tour, pages 6-7);

As per "user indicator presentation means," ICQ, as described in Quick Tour, teaches user indicators, such as user's name, ICQ's unique ID number, etc that are associated with the user. As mentioned above when one of the indicators are selected, it allows you to establish a communication with other users (Quick Tour, pages 6-7). However, ICQ, as described and illustrated in Quick Tour, fails to teach "presenting one or more user indicators within the two or more types of electronic documents, wherein the electronic documents types are capable of being generated using two or more types of applications"

ICQ, in ICQ Email Signature, describes this shortcoming. ICQ, in ICQ Email

Signature, explicitly describes enabling any other application to generate and present

the status indicator within at least one electronic document (ICQ Email Signature, page

2). ICQ enables users to select any other applications, such as Netscape 3, Microsoft

Outlook Express, Eudora, etc. and generate and insert signature, i.e., HTML user

indicator into any one of the selected applications (ICQ Email Signature, page 2).

Therefore, it would have been obvious to one having ordinary skill in the art at

the time of the invention was made to incorporate the user indicator (signature) feature

to the previous version of ICQ (How to Use ICQ) because it enhances the ICQ

communication tool and at the same time this enhancement will benefit the users of

both ICQ and non ICQ users as well.

With regard to claims 8, 15, 22, and 30-33:

The remaining independent claims, 8, 15, 22, 30-33 are rejected for the same

reason given to claim 1. Claims 30 and 32 further call for a status indication module

associated with a first system application and a communication selection module

associated with a second system application, wherein, the first and second system

applications are different system applications. ICQ, as describes in Quick Tour, also

teaches the above limitations, wherein status can be associated with e-mail, chat or

data conference applications that determines a status of a user associated with user

indicator (Quick Tour, pages 5-6). Furthermore, ICQ does provide plurality of status

determining indicators to know the status (online, offline, etc.) of one or more users on

the Internet (see page 2), wherein user's status can be associated with different applications.

<u>With regard to claims 2, 10, 16, and 24:</u>

As per claims 2, 10, 16, and 24, the ICQ user can control his/her availability to other users by choosing one of the many options; such as if the user does not want to be disturbed he clicks "Do not Disturb" option (Quick Tour, page 5). All other users receive this information as well and have a clear idea on the status.

<u>With regard to claims 3, 11, 17, and 25:</u>

As per claims 3, 11, 17, and 25, the ICQ further teaches that urgent communication request can be sent from other users and this overrides the previous "Do not Disturb" status will be replaced by "Occupied (Urgent Msgs) (Quick Tour, page 5).

<u>With regard to claims 4-7, 12-14, 18-21, and 26-29:</u>

As per claims 4-7, 12-14, 18-21, 26-29, as mentioned above, the ICQ does provide several communication mode to a user. Such communication mode includes, among others, e-mail, chat, send message files and URLs, play games, draw on whiteboards, and communicating through voice while surfing the net (Quick Tour, pages 6-7). User can initiate or establish any one of the communication modes to communicate and share at least one application with one or more users (Quick Tour, pages 6-7).

<u>With regard to claims 9 and 23:</u>

As per claims 9 and 23, as described above, ICQ also describes selecting a user indicator to establish or launch a desired mode of communication with the selected user (Quick Tour, pages 6-7).

Response to Arguments

5.   Applicants' arguments filed March 22, 2004 have been fully considered but they are not persuasive. The applicants argue that the claimed limitations or features associated with *two or more applications* of the current claims are not disclosed by the prior art of records (ICQ). That it, the Applicants argue "there is no teaching or suggestion in Quick Tour for enabling an application other than the ICQ application to generate the drop down status window. As a result, Quick Tour is deficient at least because it fails to teach or suggest generating two or more types of electronic documents using two or more types of applications and presenting one or more user indicators within the two or more types of electronic documents."

In contrast to the applicants' argument, the prior art of records does teach the above argued limitations. To begin with, applicants allege citing (page 6, lines 21-26) for "...two or more types of applications". The cited portion instead discloses documents, i.e., e-mail, HTML document, or any other electronic document.

Furthermore, ICQ (Quick Tour & Email Signature) discloses that each document is generated by its associated application, that is, e-mail document is generated by e-mail application; chat document is generated by chat application, HTML document is generated by HTML application, Telephonic document is generated by telephonic application and audio-video document is generated by audio-video application.

Furthermore, ICQ (Quick Tour & Email Signature) enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2). Thus, as described above, in the rejection of the claims, ICQ (Quick Tour & Email Signature) discloses presenting one or more user indicators within the two or more types of electronic documents. For example, the two documents can be e-mail and chat documents generated by e-mail and chat applications, respectively. ICQ also disclose presenting a status indicator in any one or more documents or applications.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (703)
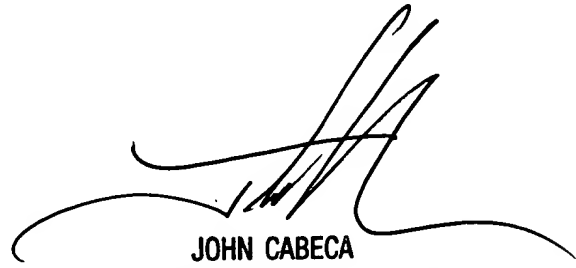
306-2799. The Examiner can normally be reached on M-F from 10:00 - 6:30 ET. If

attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, John Cabeca, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

8.   Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is

(703) 305-3900.

Tadesse Hailu
May 24, 2004

JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100